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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,493	07/21/2003	Hiroyuki Nagase	018995-735	4993

7590 03/02/2005

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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/622,493	Applicant(s) NAGASE ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 with respect to the elected and applied species is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/187,605.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>21 July 2003</u> . | 6) <input type="checkbox"/> Other: ____ |

This is in response to the election filed on 30 August 2004.

I. Applicants elect (1) compound Y-1 on page 31 of the specification, (2) potassium silicate on page 12 of the specification and (3) potassium hydroxide on pages 12 and 13 of the specification without traverse being acknowledged.

II. The elected species have been considered and searched. The consideration and search are extended to the applied species. Others have not been considered, searched or examined until all of the elected and applies species are overcome.

III. Applicants' prior art submission filed on 21 July 2003 has been considered to the extensive English language as provided in the parent application.

IV. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-10 with respect to the elected and applied species are rejected under 35 U.S.C. 102(b) as being anticipated by Lam (3,615,480).

Lam discloses, teaches, demonstrates and reduces to practice with an alkaline aqueous developer comprising potassium silicate having a ratio of silica oxide/alkali metal oxide from

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2.0-1.0, polyethylene glycol alkyl phenyl ether nonionic surfactant being read within the general formula (I) in the claims . Please see the whole disclosure of the applied reference, especially at col.2:55, 3:26-28, 56-58 and 64-66, col.5:6-8 and 34-41, col.6:6-7, Bottom of cols.5 and 6 with “DEVELOPER SOLUTIONS AND Ph VALUES” having “3” in day 1, 2 and 3, “4” in day 1, 2, 3 and 4, “5” in day 1, 2, 3, 4, 5 and 7, “6” in day 1, 2, 3 and 4 and claim 6.

Lam does not specify the functional language “has a conductivity...” in the instant claim 10. It has been considered but is reasonably inherent. Since the applied developers are shown to be same as those in the instant claims, they would inherently have the same or above the same functional property in the absence of convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since Lam et al discloses, teaches, demonstrate and reduces to practice with the claimed embodiments, they are found to be anticipated by Lam.

V. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Lam 3,615,480 considered in view of Nogami et al (5,106, 724).

Lam discloses, teaches and suggest an alkaline aqueous developer comprising potassium silicate having a ratio of silica oxide/alkali metal oxide from 2.0-1.0, polyethylene glycol alkyl

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phenyl ether nonionic surfactant being read within the general formula (I) in the claims . Please see the whole disclosure of the applied reference, especially at col.2:55, 3:26-28, 56-58 and 64-66, col.5:6-8 and 34-41, col.6:6-7, Bottom of cols.5 and 6 with “DEVELOPER SOLUTIONS AND Ph VALUES” having “3” in day 1, 2 and 3, “4” in day 1, 2, 3 and 4, “5” in day 1, 2, 3, 4, 5 and 7, “6” in day 1, 2, 3 and 4 and claim 6.

Lam does not specify the functional language “has a conductivity...” in the instant claim 10 . It has been considered but is reasonably inherent. Since the applied developers are shown to be same as those in the instant claims, they would inherently have the same or above the same functional property in the absence of convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Lam does not specify “from 0.1...% by weight...” in the instant claim 5. It is known in the art to use from 0.1% by weight or more a non-ionic surfactant of the general formula (1) in a developing agent. Nogami et al at col.3:39 to 4:32, 5:37 are cited to show the use of up to 5% by weight of a non-ionic surfactant for rapid development with full imaging detail (Table 2).

Since the above references are all related to alkaline aqueous developers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite an amount of from 0.1% by weight of a non-ionic surfactant from Nogami et al in Lam alkaline aqueous developers for a reasonable expectation of obtaining rapid development with full imaging detail.

VI. Baron et al (4,576,903), Nogami et al (5,122,438), Uehara et al (5,217,848), Shimura et al (5,234,796), Kojima et al (5,275,915), Walls (5,342,435), Tayama et al (5,480,762), Piro

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(5,670,294), Miller et al (5,811,221 and 5,914,217), Eckler (5,998,102), Miller et al (6,083,662), Fiebag et al (6,143,479 and 6,255,042) are cumulative to those applied above but may be applied when a claim is amended.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
28 February 2005

Hoa Van Le